

09/10/2003 TTAB

TTAB

IN THE UNITED STATES PATENT AND SERVICE MARK OFFICE  
BEFORE THE SERVICE MARK TRIAL AND APPEAL BOARD

In re Application Serial No.: 78/135,419

For the Mark: RMAX

Applicant: Yamaha Hatsudoki Kabushiki Kaisha Corp.

Filed on: June 13, 2002

RE/MAX INTERNATIONAL, INC.,

Opposer,

v.

YAMAHA HATSUDOKI KABUSHIKI  
KAISHA CORP.,

Applicant.

Opposition No.: \_\_\_\_\_

"EXPRESS MAIL" MAILING LABEL NUMBER: EL001171491US

I hereby certify that this paper and fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" Service under 37 CFR § 1.10 on the date indicated above and is addressed to: BOX TTAB - FEE, ASSISTANT COMMISSIONER FOR SERVICE MARKS, 2900 Crystal Drive, Arlington, VA 22202-3514 on September 3, 2003.

GREENBERG TRAURIG, LLP

By: Sandra Lee Bourassa, PLS

Sandra Lee Bourassa, PLS

BOX TTAB - FEE

Assistant Commissioner for Trademarks

2900 Crystal Drive

Arlington, VA 22202-3514



09-03-2003

U.S. Patent & TMO for TM Mail Rpt Dt. #22

**NOTICE OF OPPOSITION**

RE/MAX International, Inc., a Colorado corporation, located and doing business at 8390 East Crescent Parkway, Suite 600, Greenwood Village, Colorado 80111 (hereinafter "Opposer") believes that it will be damaged by the registration of RMAX, a mark sought to be registered through U. S. Service Mark Application Serial No. 78/135,419, filed on June 13, 2002, by Yamaha Hatsudoki Kabushiki Kaisha Corp., a corporation incorporated in Japan (hereinafter "Applicant"), and Opposer hereby opposes same.

The grounds for opposition are as follows:

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1. Opposer is a major, well-established company that provides real estate brokerage services throughout the United States through a network of franchisees, sub-franchisors and affiliated sales agents who are authorized to use Opposer's registered service marks in connection with real estate brokerage services.

2. Opposer, since at least as early as 1974, has provided real estate brokerage services in interstate commerce through brokerage offices owned and operated by it and, since at least as early as 1977, through its sub-franchisors, franchisees, and affiliated sales agents, all in connection with its distinctive registered service marks, "REMAX" and "RE/MAX". Opposer is the owner of U.S. Service mark Registration Nos. 1,139,014; 1,339,510; and 2,403,626 for its service mark "RE/MAX," and the owner of U.S. Service Mark Registration Nos. 2,106,387 and 2,054,698 for its service mark "REMAX." (Exhibit A.)

3. The common law and federal registration rights of RE/MAX are collectively referred to as the "RE/MAX marks."

4. The RE/MAX marks are used on a variety of advertising media including yard signs, business cards, newspapers and other print media, directional signs, open house signs, hot and cold air balloons, television commercials, billboards, bus stop benches, transit buses, moving vans, banners, brochures, coffee mugs and other advertising and promotional items.

5. Since at least as early as 1974, Opposer and Opposer's Affiliates have invested over two billion dollars to develop, promote and maintain the RE/MAX marks in the United States and worldwide. More specifically, Opposer's Affiliates have used the RE/MAX marks in connection with over nine million home sale transactions in the United States and worldwide, resulting in over one trillion dollars in sales volume from as early as 1974 to present date.

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6. As a result of substantial sales and extensive advertising and promotion, the RE/MAX marks have become widely and favorably known as identifying real estate brokerage services originating from, sponsored by or associated with Opposer. Indeed, the RE/MAX marks are famous. The public has to associate the RE/MAX marks as a source of high quality real estate brokerage services.

7. Applicant filed U.S. Service Mark Application Serial No. 78/135,419 on July 13, 2002, seeking to register RMAX as a word mark in connection with "industrial unmanned helicopters" in International Class 12.

8. Applicant's mark, RMAX, when used in connection with the goods identified in Application Serial No. 78/135,419 is likely to cause confusion, or to cause mistake, or to deceive consumers as to an affiliation, connection or association between Opposer and Applicant, or as to the origin, sponsorship, or approval of Applicant's goods, services or other commercial activities.

9. Opposer's RE/MAX name and marks are of sufficient fame and reputation among consumers that, when Applicant's RMAX mark is used in connection with the goods set forth in Applicant's Application, a false connection with Opposer will be presumed by consumers.

10. Applicant's RMAX mark, when used in connection with the goods identified in Application Serial No. 78/135,419, is likely to dilute the distinctive quality of Opposer's famous RE/MAX marks.

11. Applicant's use of RMAX for the services set forth in Application Serial No. 78/135,419 is not authorized by Opposer.

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12. The registration of Applicant's RMAX mark on the Principal Register would be inconsistent with Opposer's rights under the aforementioned registrations, the common law and the Trademark Act, and would be damaging to Opposer.

WHEREFORE, Opposer RE/MAX INTERNATIONAL, INC. prays that this opposition be sustained, that U.S. Service mark Application Serial No. 78/135,419 for RMAX be rejected, and that registration by Applicant be refused and denied.

A duplicate copy of this Notice of Opposition is enclosed herewith.

Respectfully submitted this 3rd day of September, 2003.

GREENBERG TRAURIG, LLP

By: John Posthumus  
John R. Posthumus  
Gayle L. Strong  
Shelley K. Barton  
1200 17th Street, Suite 2400  
Denver, Colorado 80202  
(303) 572-6500

ATTORNEYS FOR OPPOSER

09/10/2003 TAB



Nº 1139014

## THE UNITED STATES OF AMERICA

## CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof,

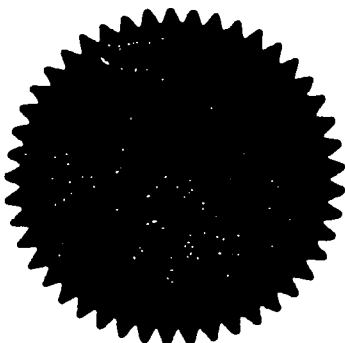
And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

## PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for Twenty Years unless sooner terminated as provided by law.



In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this twenty-sixth day of August, 1980.

*William D. Diamond*

COMMISSIONER OF PATENTS AND TRADEMARKS

09/10/2003TTAB

## **NOTICE**

*This Registration will be canceled by the Commissioner of Patents and Trademarks at the end of six years following the date of registration, unless within one year next preceding the expiration of such six years, the registrant files in the Patent and Trademark Office an affidavit showing that said mark is still in use or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. A fee of \$10.00 for each class must accompany the affidavit.*

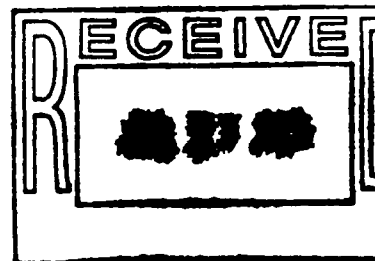
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UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

REGISTRATION NO: 1139014 SERIAL NO: 73113283 MAILING DATE: 07/09/2001  
REGISTRATION DATE: 08/26/1980  
MARK: RE/MAX  
REGISTRATION OWNER: RE/MAX INTERNATIONAL, INC.  
CORRESPONDENCE ADDRESS:

GARY L. WEIL, ESQ.  
RE/MAX INTERNATIONAL, INC.  
8390 EAST CRESCENT PARKWAY  
SUITE 600  
GREENWOOD VILLAGE, CO 80111-2800



## NOTICE OF ACCEPTANCE

15 U.S.C. Sec. 1058(a)(3)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

\*\*\*\*\*

## NOTICE OF RENEWAL

15 U.S.C. Sec. 1059(a)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 9 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE REGISTRATION IS RENEWED.

\*\*\*\*\*

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):  
035 036.

HENSON, EVERETT J  
PARALEGAL SPECIALIST  
POST-REGISTRATION DIVISION  
(703)308-9500

PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION  
CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION





Nº 1339510

## THE UNITED STATES OF AMERICA

## CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof,

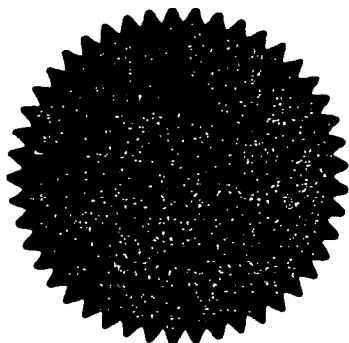
And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

## PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for Twenty Years unless sooner terminated as provided by law.



In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this fourth day of June, 1985.

Acting Commissioner of Patents and Trademarks

09/10/2003TAE

## **NOTICE**

*This Registration will be canceled by the Commissioner of Patents and Trademarks at the end of six years following the date of registration, unless within one year next preceding the expiration of such six years, the registrant files in the Patent and Trademark Office an affidavit showing that said mark is in use in Commerce or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. A fee of \$100.00 for each class must accompany the affidavit.*

09/10/1983 TAB



Int. Cl.: 36

Prior U.S. Cl.: 102

**United States Patent and Trademark Office**

**Reg. No. 1,339,510**

**Registered June 4, 1985**

**SERVICE MARK  
PRINCIPAL REGISTER**

**RE/MAX**

RE/MAX OF AMERICA, INC. (COLORADO  
CORPORATION)  
5251 S. QUEBEC  
ENGLEWOOD, CO 80111

FOR: INSURANCE BROKERAGE SERVICES,  
IN CLASS 36 (U.S. CL. 102).

FIRST USE 4-1-1980; IN COMMERCE  
4-1-1980.

OWNER OF U.S. REG. NO. 1,139,014.

SER. NO. 510,503, FILED 11-26-1984.

SHARON R. MARSH, EXAMINING ATTORNEY

# The United States of America



## CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

*The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.*

*The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office; that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Director of the United States Patent and Trademark Office; and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.*

*A copy of the Mark and pertinent data from the application are part of this certificate.*

*This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.*



Director of the United States Patent and Trademark Office

09/10/2003  
Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

**United States Patent and Trademark Office**

**Reg. No. 2,403,626**

Registered Nov. 14, 2000

**SERVICE MARK  
PRINCIPAL REGISTER**

**RE/MAX**

RE/MAX INTERNATIONAL, INC. (COLORADO CORPORATION)  
8390 EAST CRESCENT PARKWAY, SUITE 600  
GREENWOOD VILLAGE, CO 80111

FIRST USE 8-1-1995; IN COMMERCE 8-1-1995.

OWNER OF U.S. REG. NOS. 1,139,014, 2,119,607  
AND OTHERS.

FOR: PROVIDING A WEBSITE ON GLOBAL COMPUTER NETWORKS FEATURING INFORMATION IN THE FIELD OF REAL ESTATE. IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

SER. NO. 75-712,611, FILED 5-24-1999.

CAROLINE WEIMER, EXAMINING ATTORNEY

# The United States of America



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*A copy of the Mark and pertinent data from the application are a part of this certificate.*

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*Bence Lehman*

Commissioner of Patents and Trademarks

09/10/2003 TAB

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,106,387

**United States Patent and Trademark Office**

Registered Oct. 21, 1997

**SERVICE MARK  
PRINCIPAL REGISTER**

**REMAX**

RE/MAX INTERNATIONAL, INC. (COLORADO  
CORPORATION)  
5445 DTC PARKWAY, SUITE 1200  
ENGLEWOOD, CO 80155

FOR: REAL ESTATE BROKERAGE SERV-  
ICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 1-1-1977; IN COMMERCE  
1-1-1977.

OWNER OF U.S. REG. NO. 1,339,510.

SER. NO. 75-068,799, FILED 3-7-1996.

RUSS HERMAN, EXAMINING ATTORNEY

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# The United States of America



## CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

*The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.*

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*This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.*



*Bence Lehman*

Commissioner of Patents and Trademarks



09/10/2013 17:13  
Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,054,698

United States Patent and Trademark Office

Registered Apr. 22, 1997

**SERVICE MARK  
PRINCIPAL REGISTER**

**REMAX**

RE/MAX INTERNATIONAL, INC. (COLORADO  
CORPORATION)  
3445 DTC PARKWAY, SUITE 1200  
ENGLEWOOD, CO 80111

FOR: FRANCHISE SERVICES, NAMELY, OF-  
FERING TECHNICAL ASSISTANCE IN THE  
ESTABLISHMENT AND/OR OPERATION OF  
REAL ESTATE BROKERAGE FIRMS, IN  
CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 1-1-1977; IN COMMERCE  
1-1-1977.

OWNER OF U.S. REG. NOS. 1,139,014 AND  
1,173,386.

SER. NO. 75-068,927, FILED 3-7-1996.

RUSS HERMAN, EXAMINING ATTORNEY

09/10/2003TMB